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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/647,817

08/25/2003

Gregory W. Gough

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3266

7590

04/18/2006

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EXAMINER

WILLIAMS, LAWRENCE B

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

5X

<b>Office Action Summary</b>	Application No. 10/647,817	Applicant(s) GOUGH ET AL.	
	Examiner Lawrence B. Williams	Art Unit 2611	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
  - 1. ☐ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### *Specification*

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Bareis (US Patent 6,724,890 B1).

Bareis discloses in Fig(s). 1, 2, an XDSL system comprising: an impedance matching circuit in operative communication with a transmission line and an XDSL modem associated with a subscriber premises (abstract), the impedance matching circuit including a compromise impedance providing a substantial impedance match to a plurality of common impedance

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characteristics (Fig(s), 4, 7) of copper transmission lines (col. 6, line 37-col. 7, line 18; col. 8, lines 43-61).

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bareis (US Patent 6,724,890 B1).

Claim 2 inherits all limitations of claim 1 above. As noted above Bareis discloses all limitations of claim 1 above. Bareis does not disclose the exact circuitry of the compromise impedance circuit, but does teach adjustment and continued optimization of the impedance to counter environmental effects on the transmission line. It is well known in the art to use multiple devices, ie resistors, inductors, capacitors alone or in combination to achieve the same desired impedance. Therefore it would be a mere design choice to choose the combination of devices disclosed in applicant's claim 2, which do not constitute patentable subject matter.

7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bareis (US Patent 6,724,890 B1) as applied to claim 1 above, and further in view of Blon et al. (US Patent 6,542,604 B1).

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(1) With regard to claim 3, claim 3 inherits all limitations of claim 1 above. As noted above, Bareis et al. discloses all limitations of claim 1 above. Bareis does not however explicitly disclose wherein the compromise impedance has an impedance value that is approximately equal to a characteristic line impedance of the transmission line without a bridge tap.

However, Blon et al. discloses a scaled impedance replica wherein he teaches a compromise impedance has an impedance value that is approximately equal to a characteristic line impedance of a transmission line without a bridge tap (col. 4, lines 18-26).

It would have been obvious to one skilled in the art at the time of invention to incorporate the teachings of Blon et al. as a method of providing excellent echo attenuation.

(2) With regard to claim 4, Blon et al. also discloses a compromise impedance having an impedance value that is approximately equal to a characteristic line impedance of a transmission line with a bridge tap (col. 4, lines 18-26).

It would have been obvious to one skilled in the art at the time of invention to incorporate the teachings of Blon et al. as a method of providing excellent echo attenuation.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 3-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/750, 406.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of copending Application No. 09/750,406 contain(s) every element of claim(s) 1, 3, 4 of the instant application and as such anticipate(s) claim(s) 1, 3-4 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Conclusion*

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a.) Crawford discloses in US Patent 4,096,362 Automatic Cable Balancing Network.

b.) Crawford discloses in US Patent 4,096,361 Test Apparatus For Obtaining Impedance Settings For Hybrid Balance Networks.

c.) Daryanani discloses in US Patent 3,919,502 Balancing Network For Voice Frequency Telephone Repeaters.

d.) Chong discloses in US Patent 6,177,801 B1 Detection Of Bridge Tap Using Frequency Domain Analysis.

e.) Chiele discloses in US Patent 6,298,046 B1 Adjustable Balancing Circuit For An Adaptive Hybrid And Method Of Adjusting The Same.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence B Williams whose telephone number is 571-272-3037. The examiner can normally be reached on Monday-Friday (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ghayour Mohammad can be reached on 571-272-3021. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lawrence B. Williams

lbw

April 4, 2006

  
EMMANUEL B.  
PRIMARY EX